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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/559,703

12/07/2005

Reiner Fischer

PO8689/BCS033014

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08/05/2008

BAYER CROPSCIENCE LP

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EXAMINER

SULLIVAN, DANIELLE D

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

08/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/559,703	Applicant(s) FISCHER ET AL.	
	Examiner DANIELLE SULLIVAN	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-41 and 61-64 is/are pending in the application.
- 4a) Of the above claim(s) 61-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

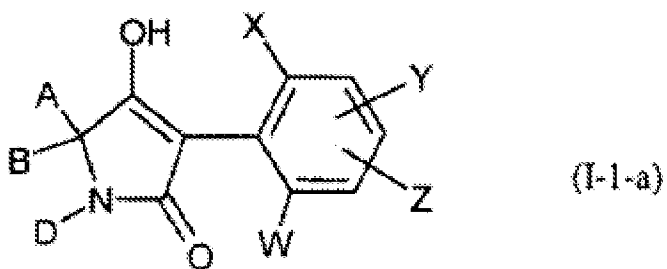
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/28/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Examiner acknowledges receipt of Applicant's response to the restriction requirement filed on 04/15/2008. Applicants elected with traverse Group I, claim(s) 36-41 drawn to a compound of Formula (I). Applicant further elected without traverse a species Ex No. I-1-a-2, as shown below:



where W and X are CH₃, Y and

D are H, Z is a 4-position pyrazole substituted by Cl and A and B complete a 6-membered ring substituted by O CH₃. Applicant traversed on the grounds that the Group I and Group XXI the method of using Formula (I) are inherently related. The Examiner respectfully disagrees with this viewpoint. The composition of Formula I can be used in a materially different process, such as a method of treating a skin disorder. For these reasons, the restriction is deemed proper and hereby made **final**.

Claims 36-41 and 61-64 are pending. Claim 1-35, 42-60 and 65-70 have been cancelled in a preliminary amendment filed on 04/15/2008. Claims 36-41 are presented for examination on the merits as they read upon the elected subject matter. Claims 61-64 are withdrawn from consideration as being drawn to non-elected subject matter.

Information Disclosure Statement

The information disclosure statement filed 06/28/2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the German references have not been translated into English. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

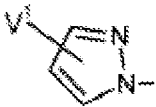
Claims 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lieb et al. (US 6,451,843).

Applicant's Invention

Applicant claims a compound of formula (I):



A and B completes a substituted unsaturated 6-membered ring; Y, D and G represent hydrogen; X and W represent methyl groups; and Z is in the 4- or 5-position

and represents: , where V¹ is chlorine.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

Lieb et al. teach a herbicidal and pesticidal compounds of formula (I) as where Y is in the 4-position and Z is in the 5-position (abstract; column 2, line 50-67). W may be hydrogen and Z may be alkyl, Y may be an optionally substituted cycloalkyl, aryl or heterocyclic group, and CKE is as defined above (column 3, lines 1 and 20). The A and B together with the carbon atom to which they are attached may represent a saturated or unsaturated unsubstituted or substituted ring (column 4, lines 23-26).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Lieb et al. do not teach Y is a pyrazole. Lieb et al. only teaches that Y is a heterocyclic group. However, a pyrazole is a heterocyclic group and is therefore taught by Lieb et al. Lieb et al. do not teach that Z is hydrogen while W is methyl. However, Lieb et al. teaches isomers where Z includes methyl and W includes hydrogen.

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

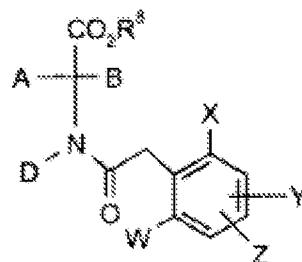
It would have been obvious to one of ordinary skill in the art at the time of the invention in view of Leib et al. to exemplify a compound where the heterocyclic group is a substituted pyrazole. One would have been motivated to include a substituted pyrazole because it is a well known heterocyclic in the art that possesses two nitrogen atoms and three carbon atoms.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention in view of Leib et al. to exemplify a compound where Z and W can isomerizes. One would have been motivated to include isomers in the Z and W position because In re Norris, 84 USPQ 458, (CCPA 1950), discloses that a novel and useful compound, which is isomeric with compounds of the prior art is not patentable where the new compound is not shown to possess new and unexpected utility. In the instant case, Leib et al. teach that the compounds are utilized for the same purpose, in herbicides and pesticides.

Claims 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lieb et al. (US 6,451,843).

Applicant's Invention

Applicant also claims the process of preparing the compound of formula (I) as



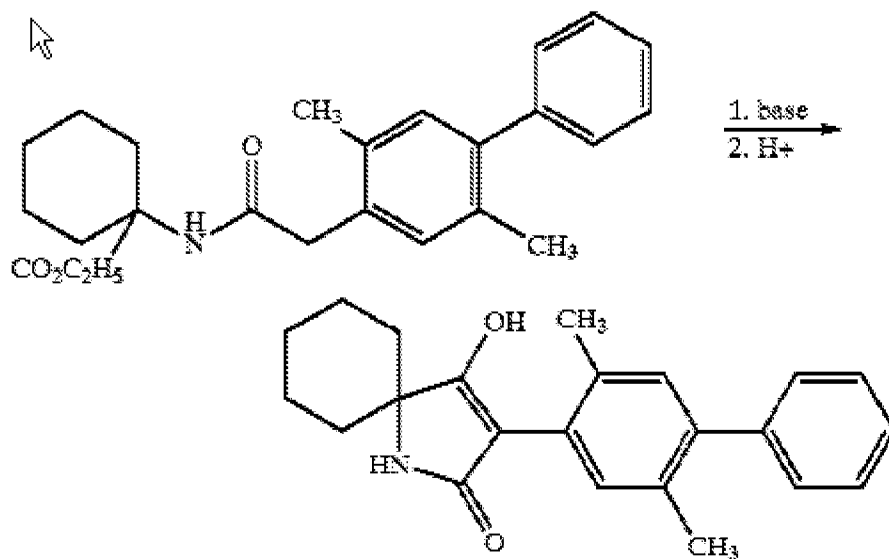
addressed above from a compound of formula (II): , in the presence of a diluent and a base, where R⁸ is an alkyl and A, B, D, X, W, Z and Y are as defined above.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

Lieb et al. teaches a process of preparing a compound of formula (I) from formula (II) by intramolecular condensation in the presence of a diluent and a base where R⁸ is ethyl; A and B complete an unsubstituted unsaturated 6-membered ring; Y, D, W and G represent hydrogen; X and Z represent methyl groups; and Y is in the 5-position and is a substituted phenyl (column 78, line 52 thru column 79, line 14, see reaction below).

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Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Lieb et al. does not exemplify a process of preparing the compound where the Y is a substituted pyrazole. However, Lieb exemplifies a process for preparing formula (I) where Y is a substituted phenyl.

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time of the invention in view of Leib et al. to exemplify a process for preparing the compound where Y is a substituted pyrazole. One would have been motivated to include a process of preparing the compound where Y is a substituted pyrazole because Leib et al. teaches a process for preparing the core compound formula (I) by intramolecular condensation in the presence of a diluent and a base. Also, Leib et al. teaches that Y may be a

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substituted heterocyclic ring which includes a pyrazole. Therefore, one would have been able to obtain the product addressed above by the disclosed process.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle Sullivan whose telephone number is (571) 270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Danielle Sullivan
Patent Examiner
Art Unit 1616

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/Johann R. Richter/
Supervisory Patent Examiner, Art Unit 1616